



Attorney Docket No. 020431.0706

Examiner: **FRANTZY POINVIL**

www

Art Unit: 3628

ய்ய

Confirmation No.: 4657

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Please file the following enclosed documents in the subject application:

1. This Transmittal with Certificate of Mailing;
2. Amended Appeal Brief; and
3. Our return postcard which we would appreciate you date stamping and returning to us.


Transmittal
Attorney Docket No. 020431.0706
U.S. Serial No. 09/686,711
Page 1

The Amended Appeal Brief is in response to a Notification of Non-Compliant Appeal Brief dated 28 February 2006. The Amended Appeal Brief is filed subsequent to the filing of an Appeal Brief, filed 25 April 2005, which included a deposit account authorization for the \$500.00 fee for filing of the Appeal Brief. Thus, no fees are deemed to presently be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

27 MARCH 2006
Date


James E. Walton, Reg. No. 47,245
Daren C. Davis, Registration No. 38,425
Brian E. Harris, Registration No. 48,383
Michael Alford, Registration No. 48,707
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (Voice)
(817) 447-9954 (Facsimile)
jim@waltonpllc.com

CUSTOMER NO. 53184

ATTORNEYS AND AGENTS FOR APPLICANT



Examiner: **FRANTZY POINVIL**

Art Unit: **3628**

Confirmation No.: **4657**

This Amended Appeal Brief is in response to a Notification of Non-Compliant Appeal Brief dated 28 February 2006. This Amended Appeal Brief is filed subsequent to the filing of an Appeal Brief, filed 25 April 2005, which included a deposit account authorization for the \$500.00 fee for filing of the Appeal Brief. Thus, no fees are deemed to presently be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees that may be required, or credit any overpayments, to Deposit Account No. 500777.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such Petition for Extension of Time and any other fee required by this document and not submitted herewith should be charged to Deposit Account No. 500777. Any refund should be credited to Deposit Account No. 500777.

Real Party in Interest (37 C.F.R. § 41.37(c)(1)(i)):

The real party in interest in the present Application is i2 Technologies US, Inc., as indicated by:

an Assignment recorded on 10 October 2000, from the inventors to i2 Technologies, Inc., in the Assignment Records of the United States Patent and Trademark Office (the "PTO") at Reel 011241, Frame 0871; and

an Assignment recorded on 30 July 2001, from i2 Technologies, Inc. to i2 Technologies US, Inc., in the Assignment Records of the PTO at Reel 012033, Frame 0372.

Related Appeals and Interferences (37 C.F.R. § 41.37(c)(1)(ii)):

There are no related appeals or declared interferences that will directly affect or be directly affected by a decision by the Board of Patent Appeals and Interferences (the "Board") in the present appeal to the knowledge of the undersigned.

Status of Claims (37 C.F.R. § 41.37(c)(1)(iii)):

The present Application claims priority from Provisional Application No. 60/204,156 filed 15 May 2000. The Application was originally filed on 10 October 2000 with thirty-six (36) claims. In an Amendment filed on 18 June 2004, claims 12 and 24 were cancelled and new claims 37-44 were added. Thus, claims 1-11, 13-23, and 25-44 are presently under consideration in the appealed Application.

In a Final Office Action dated 23 September 2004 (the "Final Office Action"), the Examiner finally rejected claims 1-11, 13-23, and 25-44 over the cited reference.

The status of the claims is, therefore, believed to be as follows:

Allowed claims:	None
Claims objected to:	None
Claims rejected:	1-11, 13-23, 25-44

Appellants hereby appeal the Examiner's final rejection of the foregoing claims (1-11, 13-23, and 25-44), which presently stand rejected over the cited reference. Appealed claims 1-11, 13-23, and 25-44 are set forth in a Claims Appendix, attached hereto, pursuant to 37 C.F.R. § 41.37(c)(1)(viii).

Status of Amendments (37 C.F.R. § 41.37(c)(1)(iv)):

Appellants filed no amendments subsequent to the Final Office Action.

Summary of Claimed Subject Matter (37 C.F.R. § 41.37(c)(1)(v)):

The independent claims involved in the present appeal relate, in general, to systems or methods involved with a computer-implemented marketplace that can provide users with services for performing various financial transactions. An example of this type of system is shown in Fig. 1. In this example, the system 10 includes a settlement marketplace 16 coupled to one or more buyers 12 and sellers 14.

The settlement marketplace includes one or more processes 24 for providing financial transaction services. Several examples of such processes are described in the Specification, including a participant qualification process, a participant performance monitoring process, a transaction selection process, and a transaction registration process, which are all discussed below.

As discussed in the specification on page 8, lines 3-21, the buyers 12, sellers 14, and settlement marketplace 16 can be associated with one or more computers. The computers can include processors and associated memory for executing instructions and manipulating information according to the operation of the system 10. For example, the one or more computers having one or more processors can constitute examples of means for providing processes, initiating processes, monitoring activities, and receiving and/or communicating notifications, orders, and payments associated with the services provided by the system 10. Data storage can be provided by a database 22. Thus, the database 22 can constitute an example of a means for storing data such as registration information and participation criteria.

The settlement marketplace can use software for providing financial services to buyers 12 and/or sellers 14. (Specification, page 9, lines 1-6) For example, the marketplace 16 can provide for payment services (Specification, page 9, lines 11-21), communication services (Specification, page 9, line 29 – page 10, line 3), as well as a variety of other services associated with domestic and international transactions (Specification, page 10, lines 9-17).

Users who participate in the financial services provided by the system 10 are referred to simply as participants. The system 10 provides for participants to be pre-qualified for participation in transactions serviced by the system 10. The specification discussed the qualification process at page 11, lines 5-29. There, the specification discusses how buyers can be judged based on criteria such as creditworthiness and their ability to complete transactions, pay for them, and timely perform other associated responsibilities. Sellers can be judged based on the quality of their goods and services, how they handle returns, customer service, etc. Financial agents, who can represent buyers or sellers, can be judged based on such things as their ability to finance transactions, handle related administrative tasks, and timely perform their duties. It is important to note lines 23-28 (page 11), which point out that participants – buyers, sellers, and agents – can be pre-qualified generally or selectively, which means they are pre-qualified for selected transactions or transactions involving selected participants. Also, as noted at lines 28-29, the qualification information can be stored in the database 22.

Another feature of the system 10 is the performance monitoring process. This process is discussed in the specification from page 11, line 30 to page 12, line 11. As noted above, participants can be pre-qualified for participation in all or select transactions. The monitoring process monitors participants to ensure that they comply with standards necessary to retain their rating, ranking, or qualification. Examples discussed in this portion of the specification include monitoring a number of returns associated with a seller, a number of returns requested by a seller, and timeliness of payment transferred by an agent. As noted at page 12, lines 10-11, the monitoring information can be stored in the database 22.

As mentioned above, participants can be pre-qualified for only selected transactions. The specification discussed a transaction selection process at page 13, lines 3-13. There, the specification discusses how participants can specify which types of transactions they wish to participate in. The selection criteria can include, for example, value limits, quality limits, types of goods and services, etc. The selection criteria can be stored in the database 22.

According to another aspect, the system 10 provides a process for registration of transactions. This process is discussed in the specification from page 13, line 23 to page 14, line 2. The registration process can include storing, in the database 22, registration information about a transaction such as transaction characteristics, timings, pay points, authorization triggers (e.g., receipt instructions that trigger payments), etc.

Financial services can be provided by the system 10 according to the diagram shown in Fig. 2 and the description in the Specification from page 16, line 4 to page 18, line 16. The diagram illustrates an example method 30 associated with an exchange scenario involving a buyer 12, a seller 14, a financial agent 60 for the buyer and a financial agent 62 for the seller. The settlement marketplace 16 handles order generation, status notification, billing, and payment operations associated with the transaction. (Specification, page 16, lines 11-23)

The method 30 includes the buyer 12 submitting instructions (arrow 34) to the marketplace 16 for ordering goods from the seller 14. In response, the marketplace 16 communicates (arrow 36) the instructions in the form of a purchase order to the seller 14. The seller 14 can then fulfill the order (arrows 40 and 42) and communicate the order status and shipping notification to the marketplace 16 (arrow 44). (Specification, page 16, line 23 – page 17, line 3)

The buyer 12, having received the goods from the seller 14, issues acceptance instructions to the marketplace 16 (arrow 52). The acceptance instructions can include payment instructions pertaining to the accepted goods. (Specification, page 17, lines 13-17)

The marketplace 16 then communicates the received payment instructions to the financial agent 60 of the buyer 12 (arrow 46). The agent 60 makes suitable payment to the financial agent 62 of the seller 16 (arrows 48). This payment from agent 60 to agent 62 can include a notification or confirmation that is sent to the marketplace 16. Upon receipt of the payment, the agent 62 issues payment acceptance instructions to the settlement marketplace 16 (arrow 54). (Specification, page 17, lines 20-28)

Having now completed the transaction, the marketplace 16 can update accounting data for the buyer 12 and for the seller 14 reflecting consummation of the transaction, including an indication of the transaction's satisfactory settlement (arrows 56, 58). (Specification, page 17, line 31 – page 18, line 3)

Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. § 41.37(c)(1)(vi)):

Issue No. 1. Claims 1-11, 13-23, and 25-36 presently stand rejected under 35 U.S.C. § 102(b) over U.S. Patent 4,799,156 to Shavit et al. ("Shavit"). Thus, the issue is whether this reference includes sufficient disclosure in order to anticipate the invention as set forth in the claims.

Issue No. 2. Claims 37-44 presently stand rejected under 35 U.S.C. § 103(a) over Shavit. Thus, the issue is whether the teachings of this reference disclose or suggest all of the limitations of the claims as necessary for establishing a *prima facie* case of obviousness, and whether the teachings of this reference can properly be considered modifiable so as to establish a *prima facie* case of obviousness.

Argument (37 C.F.R. § 41.37(c)(1)(vii)):

Claims 1-11, 13-23, and 25-36 presently stand rejected under 35 U.S.C. § 102(b) over Shavit. Claims 37-44 presently stand rejected under 35 U.S.C. § 103(a) over Shavit.

Shavit discloses an interactive market management system for interactive on-line electronic communications and processing of business transactions between a plurality of independent users, including at least a plurality of sellers, a plurality of buyers, financial institutions, and freight service providers. (Abstract and Column 5, Lines 16-20) The system includes a database that contains user information. (Abstract) Users who subscribe to the services of the interactive market management system have all the services of the system available to them, while non-subscribers may access the system and communicate with databases of subscribers who authorize access. (Column 6, Lines 4-9) Financial services can be made available via the system, allowing financial institutions to lend money to the industry to finance both the distribution channels and the buyer. (Column 8, Lines 23-26) A payment service capability is provided to the user who authorizes the system to carry its payment instructions to the user's bank. (Column 8, Lines 55-58)

Appellants respectfully submit that the rejections of claims 1-11, 13-23, and 25-36 under 35 U.S.C. § 102(b) and claims 37-44 under 35 U.S.C. § 103(a) are improper and should be reversed.

I. Issue No. 1 – Anticipation of Claims 1-11, 13-23, and 25-36:

Claims 1-11, 13-23, and 25-36 presently stand rejected under 35 U.S.C. § 102(b) over Shavit. As the following will show, the rejection is improper and should be reversed.

A. Claims 1-11, 13-23, and 25

Representative claim 1 recites:

A computer-implemented marketplace for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

a database containing:
 registration information for one or more types of transactions available to participants through the marketplace;
 participation criteria for each participant specifying one or more types of transactions in which the participant is willing to participate in association with the marketplace, each participant being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant; and
 one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants;
the marketplace operable to:
 initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and participation criteria, to provide a corresponding financial transaction service to at least one participant involved in the ongoing transaction; and
 monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction.

Independent claims 13 and 25 recite similar limitations; claim 1 is discussed as an example.

Appellants maintain that Shavit fails to disclose, teach, or suggest a database as recited in claim 1 that contains:

participation criteria for each participant *specifying one or more types of transactions in which the participant is willing to participate* in association with the marketplace, each participant being *pre-qualified to enter into the one or more types of transactions specified* in the participation criteria for the participant....

(Emphasis added.) In the Advisory Action, the Examiner cites a portion of Shavit purportedly disclosing these limitations. The cited portion of Shavit discusses how users – including buyers and sellers in variety of service areas – can subscribe to a market management system for access to all services provided by the system, and also extend system access to non-subscribers. The cited portion of Shavit recites:

Referring now to FIG. 2, there is shown a generalized block diagram illustrating the organizational relationship between market

participants (i.e., system users) and the interactive market management system 50 according to the invention. Users may include a wide variety of participants in an industry market as well as other service providers and interested users. Users who subscribe to the services of the interactive market management system have all the services of the system available to them while non-subscribers may access the system and communicate with data bases of subscribers who authorize such access. Subscribers may include such market participants as sellers (i.e. distributors 83, suppliers 84), their agents 98 (e.g., manufacturers' representatives), buyers 82, freight service providers 86, financial service providers 96, commercial service providers 88, information service providers 94, and proprietary service providers 90, as shown. The interactive market management system 50 may also be linked to other interactive market management systems 92 in other industries.

(See Advisory Action, Page 2, line 3 citing Shavit, column 5, line 67 - column 6, line 18)

This cited Shavit excerpt simply indicates that users subscribing to the interactive market management system automatically have all the services of the system available to them. There is no mention of any participation criteria indicative of "types of transactions in which [a] participant is willing to participate." Thus, the portion of Shavit relied on by the Examiner provides no evidence that Shavit discloses, teaches, or suggests a database containing "participation criteria for each participant" that "specifies one or more types of transactions in which the participant is willing to participate," as recited in claim 1.

Because Shavit fails to disclose or suggest the "participation criteria" as specifically claimed in claim 1 (i.e., criteria specifying type(s) of transactions in which a participant is willing to participate), Shavit likewise necessarily fails to disclose or suggest further limitations of claim 1 involving the claimed participation criteria. For example, claim 1 recites that "*each participant [is] pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant....*" (Emphasis added) Since Shavit is silent with respect to "the participation criteria" as claimed in claim 1, Shavit cannot disclose or suggest pre-qualifying users for transactions that meet such criteria.

Similarly, Shavit cannot disclose, teach, or suggest a marketplace operable to "initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and *participation criteria*, to provide a corresponding financial transaction service...." (emphasis added) as recited in claim 1. At

least because Shavit fails to disclose, teach, or suggest the participation criteria recited in claim 1, Shavit necessarily also fails to disclose, teach, or suggest a marketplace operable to initiate a selected process as recited in claim 1.

Appellants further maintain that Shavit fails to disclose, teach, or suggest a marketplace operable to “monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction” as recited in claim 1. In the Final Office Action, the Examiner cites a portion of Shavit – citing Shavit, column 20, line 64 – column 21, line 36 – purportedly disclosing these limitations. In response, Appellants pointed out that the cited portion of Shavit merely discloses a method for performing a level-3 security validation as part of a sign-in function. (See column 20, lines 64-67 and Figure 8) The level-3 security validation disclosed in Shavit is merely an authorization procedure verifying that the user is allowed to access a selected service, including whether a selected party is willing to communicate with the selecting party. (See column 10, lines 21-27; column 21, lines 14-30) In the subsequent Advisory Action, the Examiner instead cites a different portion of Shavit – this time citing Shavit, column 14, lines 54-62 – as purportedly disclosing these limitations. However, this alternate portion of Shavit simply discusses how the Shavit system allows a lending company to monitor and control the level of credit it has extended, including monitoring and controlling risks involved with the credit it has extended. Specifically, this portion of Shavit recites:

The commitment to pay through the network allow (sic) the lending company to monitor and control the credit utilization and risks involved with extension of credit. Additionally, the system can produce either reports or answers to inquiries at the buyer's request, subject to approval of the information provider, on a wide selection of information about its orders, shipments, invoices, outstanding loads, usage of various items, etc.

(See Advisory Action, Page 2, lines 6-7 citing Shavit, column 14, lines 54-62) Such disclosures of Shavit clearly fail to disclose, teach, or suggest a marketplace operable to “monitor activities of the at least one participant...to assess whether the participant should

continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction” as recited in claim 1.

As the many distinctions discussed above illustrate, Shavit fails to disclose, either expressly or inherently, each and every limitation recited in Appellants’ claim 1, as is required under the M.P.E.P. and governing Federal Circuit cases. For example, the M.P.E.P provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).” (M.P.E.P. § 2131) In addition, “[t]he identical invention must be shown in as complete detail as contained in the...claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).” (M.P.E.P. § 2131) Furthermore, “[t]he elements must be arranged as required by the claim.... *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).” (M.P.E.P. § 2131)

For at least these reasons, Appellants respectfully request reversal of the Examiner’s rejection of claim 1 and its dependent claims and request allowance of independent claim 1 and its dependent claims. For at least analogous reasons, Appellants also respectfully request reversal of the Examiner’s rejection of independent claims 13 and 25 and the claims depending from claim 13 and request allowance of claims 13 and 25 and the claims depending from claim 13.

B. Claims 26-36

Representative claim 26 recites:

Software operating at a computer-implemented marketplace for settling a commercial transaction between a buyer and a seller, the software being embodied in a computer-readable medium and when executed operable to:

receive an order for at least one item from the buyer, the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the

buyer, the order received from the buyer initiating a purchase transaction;
communicate the order to the seller for fulfillment of the order;
receive notification from the seller in response to shipping of the
item;
receive notification from the buyer in response to acceptance of the
item;
communicate payment instructions to at least one financial agent
associated with the buyer;
receive payment from the financial agent associated with the buyer;
communicate the payment to a financial agent associated with the
seller;
receive notification from the seller in response to acceptance of the
payment;
communicate accounting information reflecting settlement of the
transaction; and
monitor activities of the buyer in the purchase transaction to assess
whether the buyer should continue to be pre-qualified to participate in
purchase transactions.

Independent claims 31 and 36 recite similar limitations; claim 26 is discussed as an example.

Shavit, whether considered alone or in combination with knowledge generally available to those of ordinary skill in the art at the time of invention, fails to disclose, teach, or suggest various limitations recited in independent claim 26. For example, Shavit fails to disclose, teach, or suggest the following limitation recited in claim 26:

the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer, the order received from the buyer initiating a purchase transaction....

(Emphasis added) As discussed above in connection with claim 1, Shavit fails to disclose, teach, or suggest “participation criteria ...that specifies ...transactions in which the buyer is willing to participate....” as recited in claim 26. For this reason alone, it is clear that Shavit cannot anticipate claim 26. However, it can further be stated for claim 26 that, since Shavit fails to disclose, teach, or suggest the “participation criteria” specifying “transactions

in which the buyer is willing to participate,” it necessarily follows that Shavit cannot disclose, teach, or suggest the more specific limitation of “participation criteria indicating that the buyer is willing to participate in purchase transactions....” as recited in claim 26. Furthermore, as discussed above with reference to claim 1, Shavit fails to disclose, teach, or suggest “the buyer being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer” as recited in claim 26.

As another example, as discussed above with reference to claim 1, Shavit fails to disclose, teach, or suggest software operable to “monitor activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions,” as recited in claim 26.

Appellants reiterate the legal standard incumbent on the Examiner for demonstrating that a reference anticipates the claims of an application. As illustrated above, Shavit fails to disclose, either expressly or inherently, each and every limitation recited in Appellants’ claim 26, as is required under the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellants respectfully request reversal of the Examiner’s rejection of claim 26 and request allowance of independent claim 26 and its dependent claims. For at least analogous reasons, Appellants also respectfully request reversal of the Examiner’s rejection of claims 31 and 36 and the claims depending from claim 31 and request allowance of independent claims 31 and 36 and the claims depending from claim 31.

II. Issue No. 2 – Obviousness of Claims 37-44:

Claims 37-44 stand rejected under 35 U.S.C. § 103(a) over Shavit. As the following will show, the rejection is improper and should be reversed.

The M.P.E.P. sets forth the strict legal standard for establishing a prima facie case of obviousness based on modification or combination of prior art references:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(M.P.E.P. § 2143) The M.P.E.P. also provides:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(M.P.E.P. § 2143.01) "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (M.P.E.P. § 2143.01, emphasis in original) Moreover, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." (M.P.E.P. § 2143.03)

Claims 37-44

Dependent claims 37-38 (which depend from independent claim 1), dependent claims 39-40 (which depend from independent claim 13), dependent claims 41-42 (which depend from independent claim 26), and dependent claims 43-44 (which depend from independent claim 31) depend from independent claims that Appellants have shown above to be clearly allowable over Shavit. Dependent claims 37-44 are allowable for at least this reason. Additionally, dependent claims 37-44 recite further patentable distinctions over Shavit.

For example, dependent claim 38 recites that “the marketplace is further operable to automatically modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate.” Dependent claims 40, 42, and 44 recite analogous limitations. The Examiner acknowledges that Shavit fails to disclose the limitations recited in these claims. (See Final Office Action, Page 7) However, the Examiner states:

Shavit discloses an electronic marketplace wherein the marketplace is further operable to automatically modify a variety of information of participants based on automated interactive information service with the participants’ computer information systems, including the activities of the participant in the ongoing transaction (Col. 8, ll. 5-22). It would have been obvious to an ordinary practitioner of the art at the time of Applicant’s invention to modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate based on the interactive information exchange taught by Shavit to [achieve] the dramatic new automated efficiencies made available to prospective and current participants in an electronic marketplace system (Shavit, Col. 1, ll. 61-68).

(Final Office Action, Page 7.)

Even assuming for the sake of argument that Shavit disclosed “an electronic marketplace wherein the marketplace is further operable to automatically modify a variety of information of participants,” as asserted by the Examiner, Appellants respectfully submit that the Examiner still has not shown the requisite teaching, suggestion, or motivation in Shavit or in knowledge generally available to one of ordinary skill in the art at the time of Appellants’ invention to modify Shavit in the manner the Examiner proposes. Appellants respectfully submit that the Examiner’s conclusory assertion that it would have been obvious to modify the teachings of Shavit to arrive at Appellants’ invention is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) according to the standards set forth by the M.P.E.P. and the governing case law. Thus, claims 38, 40, 42, and 44 are allowable for at least this additional reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in

various prior art references, which is certainly not the case here as even the Examiner admits, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed modifications to Shavit does not, taken as a whole, suggest the claimed invention, taken as a whole. Appellants respectfully submit that the Examiner appears to have merely modified portions of Shavit, with the benefit of hindsight using Appellants' claims as a blueprint, to reconstruct Appellants' claims.

The M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states:

The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

(M.P.E.P. § 2142) The governing Federal Circuit cases are equally clear on this point, stating that "[a] critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Similarly, the Federal Circuit provides that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

With respect to the Examiner's proposed modifications to Shavit, the portion of Shavit cited by the Examiner (column 8, lines 5-22) merely disclose that, in the interactive mode, the system disclosed in Shavit may retrieve and modify information on a remote database. (See Column 8, Lines 8-12) The cited portion of Shavit does not include even the slightest reference to pre-qualification of participants, monitoring activities of the

participants in an ongoing transaction, or automatically modifying the pre-qualification of a participant (based on the monitoring) if such modification is determined to be appropriate. Appellants must conclude that the Examiner's proposed modifications to Shavit appear to be merely an attempt to reconstruct Appellants' claims, with the benefit of hindsight using Appellants' claims as a blueprint, and are unsupported by the teachings of Shavit.

Additionally, the Examiner's supposed motivation for modifying Shavit is Shavit's statement of an advantage of its system (i.e. that dramatic new efficiencies can be provided by the configuration of on-line interactive concurrent electronic services). (See Shavit, column 1, lines 61-68) It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to even attempt to modify Shavit to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, to actually modify Shavit to include pre-qualification of participants, monitoring activities of the participants in an ongoing transaction, or automatically modifying the prequalification of a participant (based on the monitoring) if such modification is determined to be appropriate, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law. This is particularly true in light of the fact that, as Appellants demonstrated above with respect to independent claim 1, Shavit fails to even disclose, teach, or suggest "participation criteria for each participant" wherein "each participant [is] pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant" and a marketplace operable to "monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction" as recited in claim 1, for example.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to modify Shavit in the manner the Examiner proposes, Appellants respectfully submit that the Examiner's conclusions set forth in the Final Office Action fall well short of

the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Appellants again respectfully submit that the Examiner's proposed modifications of Shavit appears to be merely an attempt to reconstruct Appellants' claims, with the benefit of hindsight using Appellants' claims as a blueprint, and are unsupported by the teachings of Shavit.

For at least these reasons, Appellants respectfully request reversal of the Examiner's rejection of claims 37-44 and request allowance of claims 37-44.

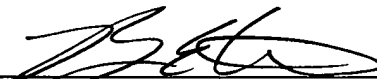
CONCLUSION:

In view of the foregoing, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the Examiner's rejections as to all of the appealed claims.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

3/27/06
Date


James E. Walton, Registration No. 47,245
Daren C. Davis, Registration No. 38,425
Brian E. Harris, Registration No. 48,383
Michael Alford, Registration No. 48,707
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
jim@waltonpllc.com (e-mail)

CUSTOMER NO. 53184
ATTORNEYS AND AGENTS FOR APPELLANTS

Appendix A – Claims Appendix
(37 C.F.R. § 41.37(c)(1)(viii))

1. **(Previously presented)** A computer-implemented marketplace for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

a database containing:

registration information for one or more types of transactions available to participants through the marketplace;

participation criteria for each participant specifying one or more types of transactions in which the participant is willing to participate in association with the marketplace, each participant being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant; and

one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants;

the marketplace operable to:

initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and participation criteria, to provide a corresponding financial transaction service to at least one participant involved in the ongoing transaction; and

monitor activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction.

2. **(Original)** The marketplace of Claim 1, wherein at least some of the registration information comprises a time limit for a transaction or one or more aspects thereof.

3. **(Original)** The marketplace of Claim 1, wherein at least some of the registration information comprises a payment point, the marketplace operable to generate payment instructions for communication to a participant in response to a transaction reaching the payment point.

4. **(Original)** The marketplace of Claim 1, wherein at least some of the participation criteria is selected from the group consisting of item type information, value information, and delivery information.

5. **(Original)** The marketplace of Claim 1, wherein the participation criteria for at least one participant comprise default criteria specifying all types of transactions.

6. **(Original)** The marketplace of Claim 1, wherein the initiated process comprises at least one associated person to assist in providing the corresponding service.

7. **(Original)** The marketplace of Claim 1, wherein the specified event comprises the initiation of the associated commercial transaction.

8. **(Original)** The marketplace of Claim 1, wherein the initiated process is operable to initiate a transfer of funds on behalf of the participant.

9. **(Original)** The marketplace of Claim 8, wherein the transfer of funds is made by a financial agent of the participant to a financial agent of a second participant through the marketplace.

10. **(Original)** The marketplace of Claim 8, wherein the initiated process is operable to generate information for communication to one or more enterprise resource planning (ERP) systems associated with the participant.

11. **(Original)** The marketplace of Claim 1, wherein at least one of the processes is a participant qualification process operable to determine the acceptability of the participant and of one or more financial agents:

from which the participant may select; and

from or to which funds may be transferred on behalf of the participant.

12. **(Canceled)**

13. **(Previously presented)** A method operating on one or more computers for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

storing registration information for one or more types of transactions available to participants through a computer-implemented marketplace

storing participation criteria for each participant which specifies one or more types of transactions in which the participant is willing to participate in association with the marketplace, each participant being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant;

providing one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants

using the marketplace to initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and participation criteria, to provide a corresponding financial transaction service to at least one participant involved in the ongoing transaction; and

monitoring activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction.

14. **(Original)** The method of Claim 13, wherein at least some registration information comprises a time limit for a transaction or one or more aspects thereof.

15. **(Original)** The method of Claim 13, wherein:
at least some registration information comprises a payment point; and
the marketplace further generates payment instructions for communication to a participant in response to a transaction reaching the payment point.

16. **(Original)** The method of Claim 13, wherein at least some of the participation criteria is selected from the group consisting of item type information, value information, and delivery information.

17. **(Original)** The method of Claim 13, wherein the participation criteria for at least one participant comprise default criteria specifying all types of transactions.

18. **(Original)** The method of Claim 13, wherein the initiated process comprises at least one associated person to assist in providing the corresponding service.

19. **(Original)** The method of Claim 13, wherein the specified event comprises initiation of the associated commercial transaction.

20. **(Original)** The method of Claim 13, wherein the initiated process initiates a transfer of funds on behalf of the participant.

21. **(Original)** The method of Claim 20, wherein a financial agent associated with the participant transfers the funds to a financial agent associated with a second participant through the marketplace.

22. **(Original)** The method of Claim 20, wherein the initiated process further generates information for communication to at least one enterprise resource planning (ERP) system associated with the participant.

23. **(Original)** The method of Claim 13, wherein at least one process is a participant qualification process that determines the acceptability of the participant and of one or more financial agents:

from which the participant may select; and

from or to which funds may be transferred on behalf of the participant.

24. **(Canceled)**

25. **(Previously presented)** A system operating on one or more computers for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

means for storing registration information for one or more types of transactions available to participants through a computer-implemented marketplace

means for storing participation criteria for each participant which specifies one or more types of transactions in which the participant is willing to participate in association with the marketplace, each participant being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the participant;

means for providing one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants

means for initiating a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and participation criteria, to provide a corresponding financial transaction service to at least one participant involved in the ongoing transaction; and

means for monitoring activities of the at least one participant in the ongoing transaction to assess whether the participant should continue to be pre-qualified to participate in transactions of the same type as the ongoing transaction.

26. **(Previously presented)** Software operating at a computer-implemented marketplace for settling a commercial transaction between a buyer and a seller, the software being embodied in a computer-readable medium and when executed operable to:

receive an order for at least one item from the buyer, the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer, the order received from the buyer initiating a purchase transaction;

communicate the order to the seller for fulfillment of the order;

receive notification from the seller in response to shipping of the item;

receive notification from the buyer in response to acceptance of the item;

communicate payment instructions to at least one financial agent associated with the buyer;

receive payment from the financial agent associated with the buyer;

communicate the payment to a financial agent associated with the seller;

receive notification from the seller in response to acceptance of the payment;

communicate accounting information reflecting settlement of the transaction; and

monitor activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions.

27. **(Original)** The software of Claim 26, further operable to communicate the order to a financial agent associated with the buyer or the seller.

28. **(Original)** The software of Claim 26, wherein the financial agent associated with the buyer is integral to the buyer.

29. **(Previously presented)** The software of Claim 26, wherein the financial agent associated with the seller is integral to the seller.

30. **(Original)** The software of Claim 26, further operable to communicate the accounting information to enterprise resource planning (ERP) functionality associated with the buyer or the seller.

31. **(Previously presented)** A method, performed at a computer-implemented marketplace, for settling a commercial transaction between a buyer and a seller, comprising:

receiving an order for at least one item from the buyer, the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer, the order received from the buyer initiating a purchase transaction;

communicating the order to the seller for fulfillment of the order;

receiving notification from the seller in response to shipping of the item;

receiving notification from the buyer in response to acceptance of the item;

communicating payment instructions to at least one financial agent associated with the buyer;

receiving payment from the financial agent associated with the buyer;

communicating the payment to a financial agent associated with the seller;

receiving notification from the seller in response to acceptance of the payment

communicating accounting information reflecting settlement of the transaction; and

monitoring activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions.

32. **(Original)** The method of Claim 31, further comprising communicating the order to a financial agent associated with the buyer or the seller.

33. **(Original)** The method of Claim 31, wherein the financial agent associated with the buyer is integral to the buyer.

34. **(Previously presented)** The method of Claim 31, wherein the financial agent associated with the seller is integral to the seller.

35. **(Original)** The method of Claim 31, further comprising communicating accounting information to enterprise resource planning (ERP) functionality associated with the buyer or the seller.

36. **(Previously presented)** A marketplace for settling a commercial transaction between a buyer and a seller, comprising:

means for receiving an order for at least one item from the buyer, the buyer being associated with stored participation criteria accessible to the marketplace that specifies one or more types of transactions in which the buyer is willing to participate in association with the marketplace, the participation criteria indicating that the buyer is willing to participate in purchase transactions, the buyer being pre-qualified to enter into the one or more types of transactions specified in the participation criteria for the buyer, the order received from the buyer initiating a purchase transaction;

means for communicating the order to the seller for fulfillment of the order;

means for receiving notification from the seller in response to shipping of the item;

means for receiving notification from the buyer in response to acceptance of the item;

means for communicating payment instructions to at least one financial agent associated with the buyer;

means for receiving payment from the financial agent associated with the buyer;

means for communicating the payment to a financial agent associated with the seller;

means for receiving notification from the seller in response to acceptance of the payment means for communicating accounting information reflecting settlement of the transaction; and

means for monitoring activities of the buyer in the purchase transaction to assess whether the buyer should continue to be pre-qualified to participate in purchase transactions.

37. **(Previously presented)** The system of Claim 1, wherein participants are pre-qualified using one or more of:

- one or more qualification ratings;
- one or more qualification rankings; and
- one or more qualification categories.

38. **(Previously presented)** The system of Claim 1, wherein the marketplace is further operable to automatically modify the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate.

39. **(Previously presented)** The method of Claim 13, wherein participants are pre-qualified using one or more of:

- one or more qualification ratings;
- one or more qualification rankings; and
- one or more qualification categories.

40. **(Previously presented)** The method of Claim 13, further comprising automatically modifying the pre-qualification of the at least one participant based on the monitoring of the activities of the participant in the ongoing transaction if such modification is determined to be appropriate.

41. **(Previously presented)** The software of Claim 26, wherein the buyer is pre-qualified using one or more of:

- one or more qualification ratings;
- one or more qualification rankings; and
- one or more qualification categories.

42. **(Previously presented)** The software of Claim 26, further operable to automatically modify the pre-qualification of the buyer based on the monitoring of the activities of the buyer in the purchase transaction if such modification is determined to be appropriate.

43. **(Previously presented)** The method of Claim 31, wherein the buyer is pre-qualified using one or more of:

- one or more qualification ratings;
- one or more qualification rankings; and
- one or more qualification categories.

44. **(Previously presented)** The method of Claim 31, further comprising automatically modifying the pre-qualification of the buyer based on the monitoring of the activities of the buyer in the purchase transaction if such modification is determined to be appropriate.

Appendix B – Evidence Appendix

No evidence is being submitted under 37 C.F.R. §§ 1.130, 1.131, or 1.132.

Appendix C – Related Proceedings Appendix

There are no known appeals, interferences, or judicial proceedings that are related to or that will directly affect, be directly affected by, or have a bearing on the Board's decision regarding this Appeal. Accordingly, no decisions on related appeals are being submitted.